

I hereby certify that this correspondence is being deposited with the United States Postal Service, so first class mail in an envelope addressed to:

Mail Stop: Petitions  
Commissioner for Patents,  
P.O. Box 1450  
Alexandria, VA 22313-1450

on

23 Jan. 2006

TOWNSEND and TOWNSEND and CREW LLP

By

Malinda Adair

PATENT

Attorney Docket No.: 018941-000200

UC Case no. B98-052

RECEIVED  
FEB 15 2006  
TECH CENTER 1600/2900

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Wilhelm Gruissem *et al.*

Patent No.: 6,781,032

Issued: August 24, 2004

For: HOMOLOGOUS  
RECOMBINATION IN PLANTS

Examiner: David T. Fox

Technology Center/Art Unit: 1638

REQUEST UNDER 37 CFR§3.81 (b)  
TO CORRECT ASSIGNEE

Mail Stop: Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR 3.81(b), Applicants request correction of the name of the assignee after issuance of the above patent. Assignments to two assignees were recorded before issuance of the patent, on August 16, 1999. (A copy of the Notice of Recordation with Assignments is attached as exhibit A.)

The failure to furnish complete assignee information, *e.g.*, recitation of a second assignee, Hitachi, Inc., at the time of submission of form PTOL-85B and payment of the issue fee, was inadvertent.

A Request for Certificate of Correction Under 37 CFR §1.323 with form PTO/SB/44 was previously filed, including the fee authorization under 37 CFR §1.20(a). (A copy of this December 12, 2005 filing is attached as exhibit B.)

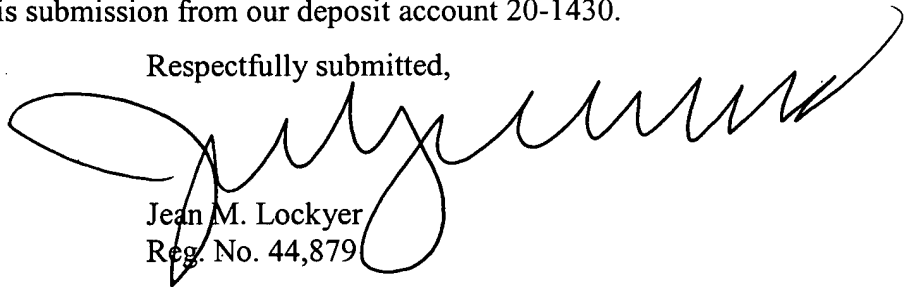
Wilhelm Gruissem et al.  
Patent No.: 6,781,032  
Page 2

PATENT

Upon grant of this Request, please forward the subject file to the Certificates of Correction Branch for issuance of a Certificate of Correction.

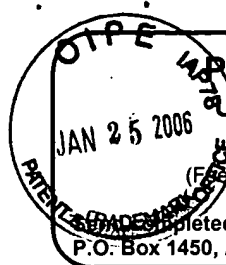
Please deduct the processing fee for this current Request, pursuant to 37 CFR §1.17(i), in accordance with the accompanying Fee Transmittal submitted in duplicate. Please deduct any additional fees associated with this submission from our deposit account 20-1430.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jean M. Lockyer', is written over the typed name and registration number.

Jean M. Lockyer  
Reg. No. 44,879

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel. (415) 576-0200  
Fax (415) 576-0300  
JML/mcd  
60684175 v1

**PROCESSING FEE**

Under 37 CFR 1.17(i)

**TRANSMITTAL**

(Fees are subject to annual revision)

Completed form to: Commissioner for Patents  
P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	09/134,014 - Pat. 6,781,032
Filing Date	August 14, 1998 - issued 8/24/04
First Named Inventor	Gruissem, Wilhelm
Art Unit	1643
Examiner Name	David T. Fox
Attorney Docket Number	018941-000200US

Enclosed is a paper filed under 37 CFR 3.81 that requires a processing fee (37 CFR 1.17(i)).

Payment of \$ 130 is enclosed.

This form should be included with the above-mentioned paper and faxed or mailed to the Office using the appropriate Mail Stop, if applicable. For transmittal of petition fees under 37 CFR 1.17(f), (g) or (h), see form PTO/SB/17p.

**Payment of Fees** (small entity amounts are NOT available for the processing fees)

- ☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 20-1430
- ☒ processing fee under 37 CFR 1.17(i) ☒ any deficiency of fees and credit of any overpayments
- Enclose a duplicative copy of this form for fee processing.

☐ Check in the amount of \$ \_\_\_\_\_ is enclosed.

☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

**Processing Fees under 37 CFR 1.17(i): Fee \$130 Fee Code 1808 for all,**  
**Except for § 1.221 papers (Fee Code 1803)**

For papers filed under:

- § 1.28(c)(3) - for processing a non-itemized fee deficiency based on an error in small entity status.
- § 1.41 - for supplying the name or names of the inventor or inventors after the filing date without an oath or declaration as prescribed by § 1.63, except in provisional applications.
- § 1.48 - for correcting inventorship, except in provisional applications.
- § 1.52(d) - for processing a nonprovisional application filed with a specification in a language other than English.
- § 1.53(b)(3) - to convert a provisional application filed under § 1.53(c) into a nonprovisional application under § 1.53(b).
- § 1.55 - for entry of late priority papers.
- § 1.71(g)(2) - to enter an amendment to the specification for purposes of 35 U.S.C. 103(c)(2) if not filed within the cited time periods
- § 1.99(e) - for processing a belated submission under § 1.99.
- § 1.103(b) - for requesting limited suspension of action, continued prosecution application (§ 1.53(d)).
- § 1.103(c) - for requesting limited suspension of action, request for continued examination (§ 1.114).
- § 1.103(d) - for requesting deferred examination of an application.
- § 1.217 - for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.
- § 1.221 - for requesting voluntary publication or republication of an application. **Fee Code 1803**
- § 1.291(c)(5) - for processing a second or subsequent protest by the same real party in interest.
- § 1.497(d) - for filing an oath or declaration pursuant to 35 U.S.C. 371(c)(4) naming an inventive entity different from the inventive entity set forth in the international stage.
- § 3.81 - for a patent to issue to assignee, assignment submitted after payment of the issue fee.

Signature

Jean M. Lockyer

Typed or printed name

January 23, 2006

Date

44,879

Registration No., if applicable

**RECEIVED**  
 FEB 15 2006  
 TECH CENTER 1600/2900

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

PATENT  
Attorney Docket No.: 018941-000200

Commissioner for Patents,  
P.O. Box 1450  
Alexandria, VA 22313-1450

on 9 Dec. 2005

TOWNSEND and TOWNSEND and CREW LLP

By Malinda Adajit

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Wilhelm Gruissem *et al.*

Patent No.: 6,781,032

Issued: August 24, 2004

For: HOMOLOGOUS  
RECOMBINATION IN PLANTS

Examiner: David T. Fox

Technology Center/Art Unit: 1638

REQUEST FOR CERTIFICATE OF  
CORRECTION UNDER §1.323

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

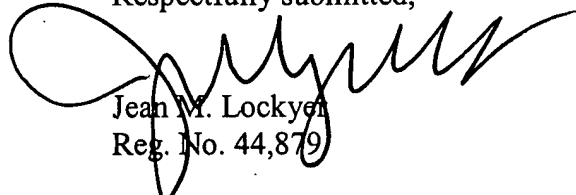
Sir:

Pursuant to 37 CFR §1.323 Applicant submits a Certificate of Correction correcting an inadvertent error by Applicant. A second assignee, Hitachi, Inc., was inadvertently omitted from the listing of assignees on the cover page of the patent.

The desired correction is set forth on form PTO/SB/44, enclosed.

Please deduct the fee, pursuant to 37 CFR §1.20(a), of \$100.00 from deposit account 20-1430 and any additional fees associated with this Certificate. This Request is submitted in duplicate.

Respectfully submitted,

  
Jean M. Lockyer  
Reg. No. 44,879

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel. (415) 576-0200  
Fax (415) 576-0300  
JML/mcd  
60654398 v1

**COPY**

**UNITED STATES PATENT AND TRADEMARK OFFICE  
CERTIFICATE OF CORRECTION**Page 1 of 1

PATENT NO. : 6,781,032  
APPLICATION NO.: 09/134,014  
ISSUE DATE : August 24, 2004  
INVENTOR(S) : Wilhelm Gruissem

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page at item (73)  
add a second Assignee: Hitachi, Ltd.  
Hatoyoma, Saitama, Japan

MAILING ADDRESS OF SENDER (Please do not use customer number below):

Jean M. Lockyer (018941-000200US)  
TOWNSEND AND TOWNSEND AND CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, CA 94111-3834

60654371 v1

**COPY**



718941-00020045  
UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
KLBastian

CERTIFICATE

OCTOBER 15, 1999

PTAS

TOWNSEND AND TOWNSEND AND CREW LLP  
KEVIN L. BASTIAN  
TWO EMBARCADERO CENTER, 8TH FLOOR  
SAN FRANCISCO, CALIFORNIA 94111-3834



\*101119785A\*

UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 08/16/1999

REEL/FRAME: 010162/0471  
NUMBER OF PAGES: 4

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

GRUISSEM, WILHELM

DOC DATE: 06/29/1999

ASSIGNOR:

JELESKO, JOHN

DOC DATE: 06/29/1999

ASSIGNOR:

FURUYA, MASAKI

DOC DATE: 06/11/1999

ASSIGNEE:

REGENTS OF THE UNIVERSITY OF  
CALIFORNIA, THE  
1111 FRANKLIN STREET, 12TH FLOOR  
OAKLAND, CALIFORNIA 94607-5200

ASSIGNEE:

HITACHI, LTD.  
HATOYOMA, SAITAMA, 350-0395, JAPAN

RECEIVED

99 OCT 25 AM 9:54

TOWNSEND & CREW

010162/0471 PAGE 2

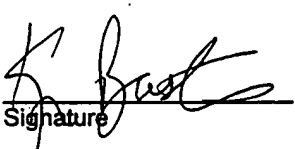
SERIAL NUMBER: 09134014  
PATENT NUMBER:

FILING DATE: 08/14/1998  
ISSUE DATE:

ALLYSON PURNELL, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

08-18-1999

MAR 8-16-99  
Attorney Jocket No. 018941-000200US

FORM PTO-1595 (Rev. 6-93)		101119785		U.S. Department of Commerce Patent and Trademark Office	
To the Honorable Asst. Commissioner for Patents. Please record the attached original documents or copy thereof					
1. Name of conveying party(ies):  Wilhelm GRUISSEM and John JELESKO  Additional name(s) of conveying parties attached? <input type="checkbox"/> Yes x No.		2. Name and address of receiving party(ies):  Name: The Regents of the University of California  Internal Address:  Street Address: 1111 Franklin Street, 12 <sup>th</sup> Floor  City: Oakland State: California ZIP: 94607-5200  Additional names and addresses attached? <input type="checkbox"/> Yes X No			
3. Nature of conveyance:  X Assignment <input type="checkbox"/> Merger  <input type="checkbox"/> Security Agreement <input type="checkbox"/> Change of Name  <input type="checkbox"/> Other:  Execution Date: June 29, 1999					
4. Application Number(s) or Patent Numbers.  If this document is being filed together with a new application, the execution date of the application is:  A. Patent Application No(s): 09/134,014  B. Patent No(s):  Additional numbers attached? <input type="checkbox"/> Yes X No					
5. Name and address of party to whom correspondence concerning document should be mailed:  Name: Kevin L. Bastian TOWNSEND AND TOWNSEND AND CREW LLP Two Embarcadero Center, 8 <sup>th</sup> Floor San Francisco, California 94111-3834 (415) 576-0200		6. Total number of applications and patents involved 1  7. Total fee (37 CFR 3.41): \$40.00  X Enclosed <input checked="" type="checkbox"/> Charge Fees to Deposit Account  <input checked="" type="checkbox"/> Charge any additional fees associated with this paper or during the pendency of this application, or credit any overpayment, to deposit account.  8. Deposit account number: 20-1430			
DO NOT USE THIS SPACE					
9. Statement and signature.  <i>To the best of my knowledge and belief, the foregoing is true and correct and any attached copy is a true of copy of the original document.</i>  Kevin L. Bastian Name of Person Signing  Atty Reg. No. 34,774   Signature  8/12/99 Date  Total number of pages including cover sheet, attachments and document 3					
10. Change Correspondence Address to that of Part 5? X Yes <input type="checkbox"/> No					
OMB No. 0651-0011 (exp. 4/94)					
Do not detach this portion					
Mail documents to be recorded with required cover to:  08/18/1999 DCOATES 00000067 201430 09134014 01 FC:501 40.00 CH  Asst. Commissioner for Patents Box: Assignments Washington, D.C. 20231					



1. Additional name(s) of conveying party(ies):  
(Continued from Page 1)

Masaki FURUYA

2. Additional name(s) and address(es) of receiving party(ies):  
(Continued from Page 1)

Hitachi, Ltd.  
Hatoyoma, Saitama, 350-0395, Japan

3. Additional application number(s) or patent number(s):  
(Continued from Page 1)

A. Patent Application No.(s)

B. Patent No.(s)

SF 150911 v1  
SF 1018581 v1



ASSIGNMENT

U.C. Case No. B98-052

For good and valuable consideration, the receipt of which is hereby acknowledged, ASSIGNOR(S),

1. Masaki Furuya 2. \_\_\_\_\_  
 3. \_\_\_\_\_ 4. \_\_\_\_\_

hereby sells, assigns and transfers to ASSIGNEE, Hitachi, Ltd. a Japanese Corporation, having its administrative offices located at Hatoyoma, Saitama, 350-0395 Japan, and the successors, assigns and legal representatives of the ASSIGNEE all of its right, title and interest for the United States and its territorial possessions and in all foreign countries in and to, any and all improvements which are disclosed in the invention entitled:

DETECTION OF HOMOLOGOUS RECOMBINATION EVENTS BY ACTIVATION OF A CHIMERIC REPORTER GENE FUSION

and which is found in

- (a) \_\_\_\_\_ U.S. provisional application filed herewith and listing the above-named persons as inventors  
 (b) \_\_\_\_\_ U.S. provisional application filed herewith and listing the above-named persons as inventors  
 (c) ☒ U.S. application serial no. 09/134,014, filed on August 14, 1998  
 (d) \_\_\_\_\_ U.S. Patent No.: \_\_\_\_\_, issued \_\_\_\_\_

and any legal equivalent thereof in a foreign country, including the right to claim priority and, in and to, all Letters Patent to be obtained for said invention by the above application or any continuation, division, continuation-in-part, extension, conversion to 35 USC 111(a) or substitute thereof, and any reissue, reexamination or extension of said Letters Patent and all rights under all International Conventions for the Protection of Industrial Property;

ASSIGNOR(S) hereby covenants that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment;

ASSIGNOR(S) further covenants that ASSIGNEE will, upon its request, be provided promptly with all pertinent facts and documents relating to said invention and said Letters Patent and legal equivalents as may be known and accessible to ASSIGNOR and will testify as to the same in any interference, litigation, or proceeding relating thereto and will promptly execute and deliver to ASSIGNEE or its legal representative any and all papers, instruments or affidavits required to apply for, obtain, maintain, issue or enforce said application, said invention and said Letters Patent and said equivalents thereof which may be necessary or desirable to carry out the purposes thereof. An attorney of record is authorized and requested by the execution of this assignment to insert into this assignment the filing date and serial number of said application when officially known.

AND the ASSIGNOR(S) requests the Commissioner of Patents and Trademarks to issue said Letters Patent of the United States and any reissue or extension thereof to the ASSIGNEE, The Regents of the University of California.

executed this

Signature of Inventor(s)

11 day of June, 1999Masaki Furuya

\_\_\_\_ day of \_\_\_\_\_, 19\_\_

\_\_\_\_\_

\_\_\_\_ day of \_\_\_\_\_, 19\_\_

\_\_\_\_\_

\_\_\_\_ day of \_\_\_\_\_, 19\_\_

\_\_\_\_\_